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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,068	10/13/1999	TAKEHIRO YOSHIDA	862.3067	6943

5514 7590 09/12/2002

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 09/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/417,068

Applicant(s)

YOSHIDA, TAKEHIRO

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1, 7, 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1: "session-based facsimile communication" in line 5 is the same with session-based data communication" in line 8; and "e-mail-based facsimile communication" in line 6 is the same with "e-mail-based data communication" in lines 8-9. The same with claims 7, 9 and 11.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 1, 3-4, 7, 9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Okada (US Patent No. 6,101,244).

Concerning claims 1, 9, 11, Okada teaches a facsimile apparatus (Fig.1) capable of performing facsimile communication via the Internet comprising communication means capable of performing session-based facsimile communication and e-mail-based facsimile communication via Internet, and control means (CPU 1) for selecting either one of session-based data communication form and e-mail-based data communication form in accordance with a selected transmission mode, and causing the communication means to execute facsimile communication in accordance with the selected data communication form (Figs. 1-4; col. 4, line 26 – col. 5, line 23; col. 6, line 1 – col. 8, line 6).

Concerning claims 3-4, Okada further teaches detection means (13) wherein the control means selects the e-mail based data communication form when the signal delay time is longer than a predetermined time, and selects the session-based data communication form when the signal delay time is shorter than the predetermined time; a registration means (5) for registering a data communication form used for facsimile communication and the control means selects a data communication form on the basis of the signal delay time, and if the control means cannot select any data communication form, detects the signal delay time (col. 4, line 26 – col. 5, line 23; col. 6, line 1 – col. 8, line 6).

Claim 7 is method claim of apparatus claim 1. Claim 7 is rejected in the same rational as claim 1 above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 5, 6, 8, 10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada as applied to claim 1 above, and further in view of Yasumoto (Japanese Patent No. JP410032671A).

Concerning claims 2, 5, 6, 8, 10, 12, Okada teaches the setting of the transmission mode to automatic selection (col. 6, lines 4-39), but fails to teach that the control means selects the e-mail-based data communication form for an A4 original size and the session-based data communication form for B4 or A3 original size. Yasumoto teaches a facsimile system capable of receiving an electronic mail and facsimile document wherein when it is e-mail, an A4 original size is selected and when it is a facsimile document form, a B4 original size is selected (Fig. 14). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of Yasumoto to record an electronic mail or a normal facsimile in different paper sizes in the system in Okada since both of them teach a facsimile system which can transmit and receive facsimile document and email messages. This combination will provide an improved facsimile system which can distinguish an electronic printed paper with a facsimile printed paper based on the size of the papers.

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Tonegawa (US Patent No. 5,905,783) discloses a data communication apparatus capable of transmitting and receiving electronic mail and facsimile document.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



Madeleine AV Nguyen
Primary Examiner
Art Unit 2622

AV
September 5, 2002